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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,156	10/19/1998	KEITH LYNN PUTNAM	98.P.7912.US	6575

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SIEMENS CORPORATION
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EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 02/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

NM

T/R

Office Action Summary	Application No.	Applicant(s)	
	09/175,156	PUTNAM ET AL.	
	Examiner	Art Unit	
	Ovidio Escalante	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 1998*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al. US Patent 5,327,486, (hereinafter Wolff).

Regarding claim 1, Wolff teaches a method and system for responding to an incoming call, (abstract), comprising:

means (18) for receiving the incoming phone call, (col. 4, lines 7-13; fig. 2 - steps 24-32; col. 9, lines 60-68);

means for generating a user alert in response to the incoming phone call, (col. 4, lines 24-27,33-37; fig. 3 - step 36; the means issues an alerting tone and displays the name and number of the caller);

means for enabling selective entry of a user message entered in response to the alert while the incoming call is pending, (col. 5, lines 1-6,57-65; fig. 8; fig. 9; the called party selects either a prestored message or a new message); and

means for playing the user message to the calling party, (col. 5, lines 4-6; fig. 2 - steps 38,42,66,68,50; the reply message is sent from the means 18 to the caller).

Regarding claim 2, Wolff teaches means for releasing the call after playing the message, (col. 5, lines 38-40).

Regarding claim 3, Wolff teaches means for displaying caller identification information to the user, (col. 4, line 35; fig. 4).

Regarding claim 4, Wolff teaches wherein the receiving means includes means for activating a user command interface (fig. 4) for a predetermined period of time following commencement of the user alert, (figs. 4-11; col. 4, lines 20-27,33-38; fig. 3 - step 36).

Regarding claim 5, Wolff teaches wherein the receiving means includes a voice recognition unit for recognizing at least one spoken command, (col. 7, lines 17-22).

Regarding claim 6, Wolff teaches wherein the at least one spoken command includes a predetermined instruction (verbal command) and a variable parameter, (variable parameter in the message-fig. 8), (col. 6, lines 17-36; col. 7, lines 5-22; fig. 8).

Regarding claim 7, Wolff teaches wherein the receiving means includes means for manually selecting the user message, (col. 5, lines 7-23,57-65; fig. 8).

Regarding claim 8, Wolff teaches wherein the means for receiving includes means for recording an audio user message, (col. 5, lines 57-65; col. 7, lines 17-22).

Regarding claim 9, Wolff teaches wherein the means for receiving includes means for storing the user message, (col. 5, lines 57-65)..

4. Claims 10,12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson et al. US Patent 5,581,604, (hereinafter Robinson).

Regarding claim 10, Robinson teaches a telephony device for playing a customized message to a caller, (abstract), comprising:

a ring detector generating a detection signal in response to an incoming call, (col. 4, lines 27-40; col. 6, lines 64-65; the telephone of Robinson will detect receipt of an incoming call);

a ringer alerting a called party to the incoming call in response to the detection signal, (col. 4, lines 41-47; the Examiner notes that it is inherent that the telephone of Robinson has a ringer since the telephone must have a means for alerting the called party of an incoming call and the Examiner further notes that most telephones "ring" to alert the called party of a call.);

a command interface for receiving one or more message parameters from the called party, (col. 4, lines 58-65; the called party records a greeting or selects a prerecorded greeting); and

a controller for activating the command interface in response to the detection signal and for transferring the customized message to the caller according to the message parameters, (col. 4, lines 65-67; col. 5, lines 25-55; col. 6, line 60-col. 7, line 6).

Regarding claim 12, Robinson teaches an audio interface (e.g., telephone) for receiving a spoken message from the called party, (col. 5, lines 37-40).

Regarding claim 13, Robinson teaches a memory for storing the spoken message, (col. 5, line 39).

Regarding claim 14, Robinson teaches a keypad permitting the called party to manually enter the message parameters, (col. 5, lines 35-37; the called party uses DTMF tones).

Regarding claim 15, Robinson teaches a caller identification unit for displaying caller information to the called party, (col. 3, lines 64-67; abstract).

5. Claims 16,18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Burg US Patent 6,219,413.

Regarding claim 16, Burg teaches a method for presenting an audio message to a telephone caller, (abstract), comprising:

detecting an incoming telephone call, (col. 4, lines 19-48; fig. 4 - steps 400,405,410,414,416,420);

generating a user alert in response to the incoming call, (col. 4, line 66-col. 5, line 3, 17-28; fig. 4 - step 426; the system will notify the called party of an incoming call by issuing a display on the called party's computer screen);

receiving a command from a called party in response to the user alert, (col. 5, lines 54-57; col. 8, lines 48-55; fig. 4 - step 426; the user sends a command to indicate whether or not they will answer the call or to send a reply);

generating a command from a called party in response to the user alert, (col. 6, lines 1-13; fig 4 - step 430);

generating an audio message based on the command, (col. 6, lines 14-45; fig. 4 - steps 430-434);

answering the incoming call, (col. 7, lines 1-15); and

playing the audio message to the telephone caller, (col. 7, lines 9-15; fig. 4 - step 434).

Regarding claim 18, Burg teaches recording a spoken message from the called party and including the spoken message in the audio message, (col. 6, lines 57-63; fig. 3B - 310,312).

Regarding claim 19, Burg teaches manually entering the command using a keypad, (figs 3A-3B; col. 6, lines 1-13).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Wolff.

Regarding claim 11, while Robinson teaches of using voice recognition for determining the caller identity, Robinson does not specifically teach of using voice recognition for receiving spoken commands that include message parameters.

Wolff teaches a voice recognition unit for receiving spoken command (col. 7, lines 17-22) that include the message parameters, (col. 6, lines 17-36; col. 7, lines 5-22; fig. 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Robinson by using voice recognition to receive spoken commands as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device. This is to make certain that the called party is an authorized user of the receiving device.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burg in view of Wolff.

Regarding claim 17, Burg, as applied above does not specifically teach of using voice recognition.

Wolff teaches activating a voice recognition unit to receive a command. (col. 7, lines 17-22; col. 6, lines 17-36; col. 7, lines 5-22; fig. 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Robinson by using voice recognition to receive spoken commands as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device. This is to make certain that the called party is an authorized user of the receiving device.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Creswell et al. US Patent 5,544,229, teaches of a system for providing personalized call treatments to a calling party.

Pepe et al. US Patent 5,742,905 teaches of a method for providing customized responses to the calling party when an incoming call has arrived, (figs. 43-45).

Leung et al. US Patent 6,005,870, teaches of a method for providing called party control of telecommunications network services utilizing a call treatment processor having an associated calling party data memory for storing calling party identification data and a call treatment table. Call treatments include such applications such as transferring to voice mail or forwarding to an alternative number.

Bannister et al. US Patent 5,548,636, teaches of a method of providing call screening to a subscriber of personal communication services which facilitates the screening of incoming calls by associating the number dialed by a calling party with a function or role of the dialed number.

A subscriber can decide whether to answer the incoming call based upon knowing the role or context associated with the dialed number.

Nabkel US Patent 5,963,626 teaches a method for providing a customized message to an incoming call based upon their identity.

Norman et al. US Patent 6,055,305 teaches of a method for providing customized call treatments to incoming callers.

12. Any response to this action should be mailed to:

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or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA, Sixth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 872-9314.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante
Examiner
Group 2645
February 11, 2002

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600